

Art Unit: 2623  
Examiner: J. R. Sheleheda  
U.S. Patent Application Serial No.: 09/884,131  
Response to November 15, 2006 Office Action  
Docket: BS00052

### **REMARKS**

In response to the Office Action dated November 15, 2006, the Assignee respectfully requests reconsideration of the application based on the remarks and amendments submitted herewith. The Assignee respectfully submits that the pending claims already distinguish over the cited references to *Schiller*, *Shah-Nazaroff*, and *Decinque*, whether considered alone or in combination.

Claims 1-29 and 44-48 are pending in this application. Claims 30-43 were withdrawn in response to the Election/Restriction Requirement mailed May 25, 2005. Claims 1, 11, 19, 22, 27 and 44 are amended. Support for the claim amendments is found in the Specification at paragraphs [0014] and [0015], for example. No new matter is submitted. Accordingly, entry and consideration of this Amendment is respectfully requested.

### **Telephone Interview**

The Assignee appreciates the courtesies extended by Examiner James Sheleheda and Supervisory Patent Examiner (SPE) Chris Kelly in conducting the telephonic Interview of January 30, 2007, the Assignee's record of which is comprised of the amendments and remarks made herein. During the Interview, the Assignee maintained that none of the currently applied references to *Schiller*, *Shah-Nazaroff* and *Decinque* teach or suggest providing "*a bundle of content having a full schedule of programming, the bundle of content having diverse subject matter with all the content related to the geographic terrain,*" as recited in each of the pending independent claims 1, 11, 19, 22, 27 and 44. Nonetheless, in the interests of furthering prosecution and securing an allowance in this matter, the Assignee further amends each of the pending independent claims, as suggested in the Interview, to clarify that the "*bundle of content*" is transmitted to "*an audience*" (claims 1, 11, 19, 22 and 27) or "*viewers*" (claim 44) having "*an interest in the geographic terrain.*" As discussed during the Interview, the combination of

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features now recited in the pending independent claims is believed to distinguish over the applied references. Accordingly, a prompt allowance of all pending claims is respectfully solicited.

### **Rejections of Claims under § 103 (a)**

In the Office Action, claims 1-7, 9-13, 15-27 and 29 are rejected under 35 U.S.C. § 103 (a) as allegedly unpatentable over U.S. Patent No. 5,499,046 to Schiller, *et al.* (hereafter "*Schiller*"), claims 44-46 and 48 are rejected under 35 U.S.C. § 103 (a) as allegedly unpatentable over *Schiller* in view of U.S. Patent No. 6,317,881 to Shah-Nazaroff, *et al.* (hereafter "*Shah-Nazaroff*"), claims 8, 14 and 28 are rejected under 35 U.S.C. § 103 (a) as allegedly unpatentable over *Schiller* in view of U.S. Patent No. 6,286,139 to Decinque (hereafter "*Decinque*"), and claim 47 is rejected under 35 U.S.C. § 103 (a) as allegedly unpatentable over *Schiller* in view of *Shah-Nazaroff* and *Decinque*. For the following reasons, these rejections are respectfully traversed.

To establish a *prima facie* case of obviousness, three criteria must be met: 1) the Examiner must identify "some suggestion or motivation ... to modify the reference"; 2) the Examiner must identify "a reasonable expectation of success"; and 3) "the prior art reference must teach or suggest all the claim limitations." DEPARTMENT OF COMMERCE, MANUAL OF PATENT EXAMINING PROCEDURE, §2143 (orig. 8<sup>th</sup> Edition) (hereafter "MPEP"). The Examiner thus bears the initial burden of factually supporting any *prima facie* case of obviousness. *See id.* at § 2142. "If the Examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness." *Id.* Only when the Examiner makes a *prima facie* case does the burden shift to the applicant to present evidence of nonobviousness. *See id.* In view of this, the current Office Action fails to establish a *prima facie* case of obviousness for at least the following reasons.

1. ***Schiller* Fails to Teach or Suggest All the Claimed Features, thus Failing to Support a *Prima Facie* Case of Obviousness**

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Claims 1-7, 9-13, 15-27 and 29 cannot be obvious over *Schiller*. These claims recite, or incorporate, features that are not taught or suggested by *Schiller*. Independent claims 1, 11, 19, 22, 27 and 44 are each generally directed to a system or method for delivering media content to subscribers, the content being related to a specific type of geographic terrain. Claim 1 is representative and recites, *inter alia*, a channel producer that receives, bundles and transmits content, the bundle of content "*having a full schedule of programming...[and] diverse subject matter with all the content related to the geographic terrain.*" As suggested in the Interview, claim 1 is further amended to recite that the "bundle of content" is transmitted to "an audience" having "an interest in the geographic terrain." Independent claims 11, 19, 22, 27 and 44 recite similar features.

*Schiller* is entirely silent to these features. Examiner Sheleheda is correct — *Schiller* discloses a CATV distribution system with a plurality of headends outputting different programs to subscribers via a plurality of channels. See, e.g., U.S. Patent 5,499,046 to Schiller, *et al.* (March 12, 1996) at Abstract. *Schiller*, however, does not disclose or suggest that the content of all of its programs are "*related to the [specific type of] geographic terrain.*" In fact, *Schiller* does not expressly disclose or even suggest that any of its programs are related to geographic terrain. Moreover, Examiner Sheleheda concedes that nothing in *Schiller* discloses or suggests that the distributed programming is "*related to the [specific type of] geographic terrain,*" as recited in each of the pending independent claims. Still further, *Schiller* is silent with respect to the audience to which its bundle of content is transmitted, whereas the pending claims recite that the "*bundle of content*" is transmitted to "*an audience*" or "*viewers*" having "*an interest in the geographic terrain.*" Because *Schiller* is entirely silent to at least these features, one of ordinary skill in the art would not think that claims 1-7, 9-13, 15-27 and 29 are obvious. The *prima facie* cases for obvious must, therefore, fail.

Moreover, the Assignee must strongly, yet respectfully, disagree with the Examiner's statements. In the Office Action Examiner Sheleheda asserts that the pending claims are simply

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a rearrangement of material disclosed or suggested in *Schiller*. Examiner Sheleheda, however, provides no credible support for this assertion. Even assuming, *arguendo*, that some of the programming distributed on NICKELODEON® or CNN® may be related to a geographic feature (such as mountains), *Schiller* nowhere discloses or suggests the distribution of a bundle of content “*having a full schedule of programming ... [and] diverse subject matter with all the content related to the geographic terrain,*” as recited in the independent claims (emphasis added). Remember, Examiner Sheleheda concedes that *Schiller* fails to teach or suggest a full schedule of content of diverse subject matter, all of which is related to the geographic terrain, as in each of the pending independent claims. So, the Office’s bald assertions are, very respectfully, not supported by the facts.

Claims 1-7, 9-13, 15-27 and 29, therefore, cannot be obvious. Because *Schiller* is entirely silent to many features in these claims, one of ordinary skill in the art would not think that these are obvious over *Schiller*. The Office has thus failed to meet its burden of establishing a *prima facie* case of obviousness. Accordingly, withdrawal of the 35 U.S.C. § 103 (a) rejection of claims 1-7, 9-13, 15-27 and 29 is respectfully requested.

**2. Because the Combination of *Schiller* and *Shah-Nazaroff* or *Decinque* Fails to Teach or Suggest All the Claimed Features, the *Prima Facie* Case Must Fail**

Claims 8, 14 28, and 44-48 were rejected as being obvious over *Schiller* in view of *Shah-Nazaroff* and/or *Decinque*. The combination of *Schiller* with *Shah-Nazaroff* and/or *Decinque*, however, cannot obviate these claims. The combined teaching of these documents still fails to teach or suggest many claimed features. As the above paragraphs explained, all the independent claims generally recite delivering a bundle of content related to a geographic terrain, the content, *inter alia*, “*having a full schedule of programming ... [and] diverse subject matter with all the content related to the geographic terrain,*” and the content being transmitted to “*an audience*” or “*viewers*” having “*an interest in the geographic terrain.*” All other claims ultimately depend from one of these pending independent claims.

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The combined teaching of *Schiller*, *Shah-Nazaroff*, and/or *Decinque* remains silent to many of the claimed features. The Office concedes, as mentioned above, that nothing in *Schiller* discloses or suggests that the distributed programming is “related to the [specific type of] geographic terrain,” as recited in each of the pending independent claims. The combined teaching of *Schiller* with *Shah-Nazaroff* and/or *Decinque* does not cure this deficiency. *Shah-Nazaroff* discloses a method and apparatus for collecting and providing viewer feedback to a broadcast. See U.S. Patent 6,317,881 to Shah-Nazaroff, *et al.* (November 13, 2001) at column 1, lines 64-66. *Shah-Nazaroff* is not applied for, and does not disclose or suggest, the delivery of media content related to a geographic terrain, the content “having a full schedule of programming ... [and] diverse subject matter with all content related to the geographic terrain” as recited in the pending independent claims. Likewise, *Decinque* is not applied for, and does not disclose or suggest, the delivery of media content related to a geographic terrain, the content “having a full schedule of programming ... [and] diverse subject matter with all content related to the geographic terrain.” Rather, *Decinque* discloses a system for ordering video content using the Internet. See U.S. Patent 6,286,139 to Decinque (September 4, 2001) at column 1, lines 55-65. Further, none of *Schiller*, *Shah-Nazaroff* or *Decinque* teach, disclose or suggest transmitting such “bundled content” to “an audience” or “viewers” having “an interest in the geographic terrain” as recited in each of the pending independent claims.

Claims 8, 14 28, and 44-48, then, cannot be obvious. The combined teaching of *Schiller* with *Shah-Nazaroff* and/or *Decinque* fails to teach or suggest the delivery of media content related to a geographic terrain, the content “having a full schedule of programming ... [and] diverse subject matter with all content related to the geographic terrain” or “an audience” or “viewers” having “an interest in the geographic terrain” as recited by, or incorporated in, the pending claims. Because the proposed combination of *Schiller* with *Shah-Nazaroff* and/or *Decinque* is entirely silent to many features in these claims, one of ordinary skill in the art would not think that these are obvious. The Office has thus failed to meet its burden of establishing a

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*prima facie* case of obviousness. Accordingly, withdrawal of the 35 U.S.C. § 103 (a) rejection of claims 8, 14 28, and 44-48 is respectfully requested.

**3. Because No Reasonable Expectation of Success was Cited, the *Prima Facie* Case Is Defective**

The Examiner's alleged *prima facie* cases are defective. A *prima facie* case for obviousness must include "a reasonable expectation of success." MPEP at § 2143. Here, however, no basis has been cited in the Office Action for successfully combining *Schiller*, with either of *Shah-Nazaroff* or *Decinque*, to provide a system or method of delivering media content related to a geographic terrain, the content "*having a full schedule of programming ... [and] diverse subject matter with all content related to the geographic terrain,*" and the content being transmitted to "*an audience*" or "*viewers*" having "*an interest in the geographic terrain,*" as recited in the pending independent claims. All other claims ultimately depend from one of claims 1, 11, 19, 22, 27 and 44. Because the Office has entirely failed to make such a finding, the Office has failed to properly establish a *prima facie* case for obviousness. Due Process thus demands that the Office withdraw the 35 U.S.C. § 103 (a) rejections of claims 1-29 and 44-48 based on any combination of *Schiller*, *Shah-Nazaroff* and/or *Decinque*

**Solicitation of Allowance**

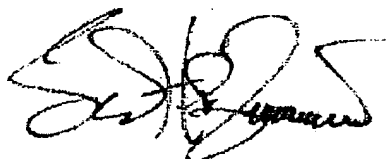
The Assignee submits that all pending claims are patentable. The pending claims have been twice examined, appealed, and now again examined. All the cited documents, however, remain silent to the delivery of media content related to a geographic terrain, the content "*having a full schedule of programming ... [and] diverse subject matter with all content related to the geographic terrain.*" This feature has been successfully appealed, and yet the newly cited documents to *Schiller*, *Shah-Nazaroff*, and *Decinque* remain silent to at least this feature. Moreover, the cited documents also remain silent with respect to the transmission of such content to "*an audience*" or "*viewers*" having "*an interest in the geographic terrain,*" which

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features have been incorporated into the pending independent claims as suggested in the Interview. The Assignee thus requests that the next action include a thorough search for relevant documents. If the search is unsuccessful, the Assignee respectfully solicits a prompt Notice of Allowance of claims 1-29 and 44-48. Moreover, to the extent that withdrawn claims 30-43 recite similar features not taught or suggested in the applied references, rejoinder and allowance of claims 30-43 is respectfully solicited.

Of course, if the Examiner determines that anything further is desirable to place this application in even better form for allowance, the Examiner is invited to contact the Assignee's representative at (919) 469-2629 or [scott@wzpatents.com](mailto:scott@wzpatents.com).

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Scott P. Zimmerman', with a stylized flourish at the end.

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